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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,464	08/25/2003	James D. Ralph	F-286	8288

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SPINECORE, INC.
447 SPRINGFIELD AVENUE
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EXAMINER

BLANCO, JAVIER G

ART UNIT PAPER NUMBER

3738

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,464

Applicant(s)

RALPH ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: please update the "CROSS-REFERENCE TO RELATED APPLICATIONS". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 4-5, 7, and 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 7, 9, 10, 13, 16, 17, and 20 of copending Application No. 10/642,526 (= US 20040034421 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other both applications recite plate members having an external surface (= contact element) comprising a deflectable, convex/domed, porous wire mesh.
4. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-23 of U.S. Patent No. 6,764,515 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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the difference between claims 1-12 of this application and claims 20-23 of U.S. Patent No.

6,764,515 B2 lies in the fact that the patent claims include many more elements and is thus much more specific. Thus the invention of claims 20-23 of U.S. Patent No. 6,764,515 B2 is in effect a “species” of the “generic” invention of claims 1-12 of this application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 1-12 of the application are anticipated by claims 20-23 of U.S. Patent No. 6,764,515 B2, it is not patentably distinct from claims 20-23 of U.S. Patent No. 6,764,515 B2.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ralph et al. (US 5,989,291 A).

As seen in Figures 3b, 4, 5, and 7-9, Ralph et al. disclose an intervertebral spacer device comprising first and second plate members (e.g., 100a, 100b), each having an external plate surface (e.g., 102a, 102b) thereof, the plate members being disposed such that the external plate surfaces face in opposite directions, at least one of the external plate surfaces having a mesh

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thereon (e.g., circumferential wall 120). Circumferential wall 120 is disclosed (see column 6, lines 13-17) as being disposed “exterior of the device” (compare Figure 3b to Figure 4: flanges 108a, 108b comprise an external surface of plate members 100a, 100b). Circumferential wall 120 is also disclosed as comprising a porous fabric (i.e., by definition, a wire mesh) and as being resilient and flexible (i.e., deflectable; see column 3, lines 8-18; column 6, lines 17-21). Figures 4 and 9 show circumferential wall 120 as convex. Additionally, Ralph et al. disclose plate members 100a, 100b as convex (see column 2, lines 61-63) and as having a porous coating (see column 3, lines 4-6; column 5, lines 57-61). Further, Ralph et al. disclose ball-shaped head 207 to be received and hold within curvate volume 233 (see columns 6, 7).

7. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boyd et al. (US 5,425,773 A).

As seen in Figures 5 and 6, Boyd et al. disclose an intervertebral spacer device comprising first and second plate members, each having an external plate surface thereof, the plate members being disposed such that the external plate surfaces face in opposite directions, at least one of the external plate surfaces having a convexly shaped (see column 9, lines 1-6) porous coating (see column 9, line 52 to column 10, line 2). Boyd et al. also disclose a ball-shaped structure (e.g., ball 146) to be received and hold within a curvate volume (e.g., socket 126).

8. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gordon et al. (US 6,579,321 B1).

As seen in Figures 1 and 3, Gordon et al. disclose an intervertebral spacer device comprising first (character 20) and second (character 22) plate members, each having an external

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plate surface thereof, the plate members being disposed such that the external plate surfaces face in opposite directions, at least one of the external plate surfaces having a convexly shaped (see column 5, lines 58-62; column 6, lines 5-6) porous wire mesh surface (see column 4, lines 30-35; column 6, lines 8-10). Gordon et al. also disclose a ball-shaped structure (e.g., ball 18) to be received and hold within a curvate volume (e.g., cavity 24 and/or lower seat of second disc member 22).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Gayer et al. (US 6,214,049 B1) and Eckman (US 2003/0135278 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB



August 20, 2004



David H. Willse
Primary Examiner